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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Franklin C. Bradshaw

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10/25/2007

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EXAMINER

SELLS, JAMES D

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

10/25/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/664,794

**Applicant(s)**

BRADSHAW ET AL.

**Examiner**

James Sells

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims <sup>36-46</sup>~~36~~ are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Matsuo et al (US Patent 5,480,509).

Regarding claim 36, Matsuo discloses a laminating apparatus. As shown in Figs. 1 and 2a-c, the apparatus comprises a frame having an outer shell including lower outer shell R3 and an upper outer shell Ramovably connected to the lower shell portion for movement between an open position (see Figs. 2a-c) and a closed position (see Fig. 1). The apparatus includes a pair of cooperating structures 10a and 10b located within the outer shell and positioned adjacent one another in a cooperating pressure applying relationship to apply pressure to materials fed therethrough. Upper pressure roller 10a is connected to the upper outer shell R1 such that (a) movement of the upper shell to the open position moves the upper pressure applying structure apart from the lower one to facilitate positioning of feed materials 6a and 6b between the cooperating structures and (b) movement of the upper outer shell portion to the closed position positions the upper cooperating structure 10a adjacent the lower cooperating structure 10b in the cooperating pressure applying relationship. Frames R1 and R3 and constructed to receive and mount supply rolls 5a and 5b of first and second feed materials 6a and 6b.

Matsuo does not explicitly disclose manually engaging the upper outer shell portion directly and lifting the upper outer shell portion upwardly to the open position thereof as claimed by the applicant. However, it is the examiner's position that the apparatus of Matsuo is *inherently* capable of manual movement to lift the upper outer shell portion to the open position in the manner claimed by the applicant.

Regarding claim 37, upper and lower shell portions R1 and R3 are pivotally connected to each other at support shaft 2. See col. 4, lines 46-51.

Regarding claim 38, outer shell portions R1 and R3 are shown with upper and lower side walls (see upper and lower frame members 1a and 1b in Figs. 14a and 16) pivotally connected at support shaft 2.

Regarding claim 39, the side walls shown in Fig. 13 appear to be parallel to each other.

Regarding claim 40, feed tray or platform 21 is mounted between the lower side wall portions for supporting and guiding materials between the cooperating structures.

Regarding claims 41 and 42, cooperating pressure applying structures 10a and 10 comprise rotatable nip rollers.

Regarding claim 43, upper and lower shell portions R1 and R3 are pivotally connected to each other at support shaft 2 for relating movement. See col. 4, lines 46-51.

Regarding claim 44, outer shell portions R1 and R3 are shown with upper and lower side walls (see upper and lower frame members 1a and 1b in Figs. 14a and 16) pivotally connected at support shaft 2.

Regarding claim 45, the side walls shown in Fig. 13 appear to be parallel to each other.

Regarding claim 46, feed tray or platform 21 is mounted between the lower side wall portions for supporting and guiding materials between the cooperating structures.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 47-48 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Matsuo et al (US Patent 5,480,509).

Regarding claims 47-48, Matsuo does not expressly disclose manually engaging the upper frame of the Figs. 11-12 embodiment or the Figs. 17-18 prior art apparatus and lifting the upper frame to an opened position as required by the here claimed method. Significantly, Appellants' Specification also does not expressly disclose the manually engaging step of claim 47, and the May 16, 2001 Amendment of claim 47 which added this step does not assert that the Specification contains such express disclosure. Apparently, notwithstanding the lack of express disclosure, Appellants believe that an artisan would appreciate the upper outer shell portion is moved to an opened position by manual engagement, and likewise it seems appropriate to find that

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an artisan would appreciate the upper frame of Matsuo's Figs. 11-12 and 17-18 is moveable to an opened position by manual engagement notwithstanding the lack of express disclosure. This finding is supported by the fact that Matsuo (like Appellants) does not disclose any non-manual mechanism for moving the upper frame to an opened position. For these reasons, as well as the reasons discussed previously with respect to claim 36, it appears that the Figs. 11-12 and 17-18 disclosures of Matsuo anticipatorily satisfy the limitations of method claims 47-48.

Alternatively, it appears that claims 47-48 are unpatentable under 35 U.S.C. § 103(a) over the aforementioned disclosures of Matsuo. Although Matsuo (like Appellants) does not expressly disclose opening the upper frame by manual engagement, Matsuo discloses manual operations for other aspects of Figs. 11-12 (col. 11, 11.47-54) and Figs. 17-18 (col. 2, 11.31-36). These disclosures of manual operations create an inference that the upper frame of Figs. 11-12 or Figs. 17-18 is moved to an opened position by manual engagement, and this inference is reinforced by the previously mentioned fact that the Matsuo reference contains no disclosure of a non-manual mechanism for moving the upper frame to an opened position. In this regard, we point out that an analysis under § 103 need not seek out precise teachings directed to the specific subject matter of the challenged claim, for it is appropriate to take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (Fed. Cir. 2007). Accordingly, in light of the inferences derived from Matsuo, it appears that one with ordinary skill in this art would have found it obvious to move the

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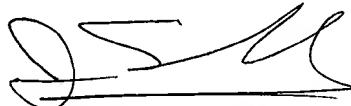
upper frame of Figs. 11-12 or Figs. 17-18 to the opened position by manual engagement as required by method claim 47.

***Telephone/Fax***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is 571-272-1237. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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